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EXAMINER

LE, HOA VAN

ART UNIT PAPER NUMBER

1752

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/768,440

Applicant(s)

HIRANO ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) 12, 14 and 16-18 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 and 13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This is in response to Papers filed on 22 May 2006.

I. Newly submitted claims 16-18 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The newly added independent set of claims are related to a method for producing a silver halide photographic material that has patentable distinctions from those in the elected invention of claims 1-14 being related to silver halide photographic material. Accordingly, the newly added independent set of claims 16-18 requires separate considerations and searches. Additional searches are burdensome.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16-18 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

II. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are

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subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

III. This application contains claims 16-18 are drawn to an invention nonelected by original presentation for prosecution on the merits. The claims are insufficient for a rejoinder. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

IV. The amendment filed 22 May 2006 is objected to under 35 U.S.C. 132(a)

because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The language "one" in the newly added embodiments in claim 1 finds no support and raises the issue of new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

V. The record shows that applicants elect formula I species. It has been considered and searches. During the course of searches for the elected species, a compound being read on the general formula III is found and applied. Others have not been considered, searched or examined until all of the elected and applied species are overcome. Accordingly, claims 12 and 14 are withdrawn until all of the elected and applied species are overcome.

VI. Claims 1-11 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The language "one" in the newly added embodiments in claim 1 finds no

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support and raises the issue of new matter.

VII. In view of the amendment and arguments on the record filed on 22 May 2006, the applied reference with respect to Sudo et al (5,424,170) as primary reference is withdrawn.

VIII. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-9 and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Arai (6,013,410).

Arai discloses and teaches a silver halide photographic material comprising a support having thereon a hydrophilic colloid layer and a silver halide emulsion layer comprising about 40 mol% of silver bromide being spectrally sensitized with sensitizing dye “d-1” being read on and within the genera formula III in the claims and a composite latex being formed from hydrophobic monomers and inorganic

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microparticles. Please see the whole disclosure of the applied references, especially at col.3:38 to 4:43, 21:3-46, 31:60-63, 33:38-41, cols.39 and 40:40 to 51:15 in which, patentee does specify the property of “a surface resistivity...” as those in claims 3 and 6 or “conductive polymer” as that in claim 5 or “spectral sensitizing dye...” as that in claim 8. At the level of one skilled in the art, it has reasons to believed that the properties are inherent for layer(s) containing polymer(s) have anionic groups and/or metal oxide particles as ionically conductive materials and the art. Applicants should convincingly provide an evidence to the contrary as it is allowed by law to request and require applicants to do so for a patentability of the properties in the next response to this Office action in order for it to be considered timely in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429 since arguments alone is not factual evidence. An allowed claim or a patent would have no value if someone later shows the properties as set forth on the record. Since Arai are reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Arai. In an alternative, embodiments are disclosed, taught or suggested but are not in an example, they are reasonably found to be rendered *prima facie* obvious by Arai.

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IX. Claims 7 and 10-11 are rejected under 35 U.S.C. 103(a) as obvious over Arai (6,013,410) considered in view of Morishima et al (5,994,040) and Sudo et al (5,424,170).

Arai discloses and teaches a silver halide photographic material comprising a support having thereon a hydrophilic colloid layer and a silver halide emulsion layer comprising about 40 mol% of silver bromide being spectrally sensitized with sensitizing dye "d-1" being read on and within the genera formula III in the claims and a composite latex being formed from hydrophobic monomers and inorganic microparticles. Please see the whole disclosure of the applied references, especially at col.3:38 to 4:43, 21:3-46, 31:60-63, 33:38-41, cols.39 and 40:40 to 51:15 in which, patentee does specify the property of "a surface resistivity..." as those in claims 3 and 6 or "conductive polymer" as that in claim 5 or "spectral sensitizing dye..." as that in claim 8. At the level of one skilled in the art, it has reasons to believed that the properties are inherent for layer(s) containing polymer(s) have anionic groups and/or metal oxide particles as ionically conductive materials and the art. Applicants should convincingly provide an evidence to the contrary as it is allowed by law to request and require applicants to do so for a patentability of the properties in the next response to this Office action in order for it to be considered timely in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429

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since arguments alone is not factual evidence. An allowed claim or a patent would have no value if someone later shows the properties as set forth on the record.

Arai does not specify bromide ion in mol% as that in claim 7, an amount of coated silver as that in claim 10. However, it is known in the art to obtain and use up to 79.6 mol% of bromide ion for high sensitivity and rapid process and less than 3 g/m² of silver for sufficient camera sensitivity as disclosed, taught and suggested in Morishima et al (5,994,040) at col.83;67 to 94:4, 191:23 and 192:32.

Arai does not specify a compound of the elected formula I. However, it is known in the art to obtain and use spectral sensitizing dye "d" (In Sudo et al at the last lines on cols. 59 and 60 to first chemical structure on col. 61) being read on and with the elected general formula I for a reasonable expectation of obtaining high sensitivity in the art.

Since the above references are related to silver halide photographic materials, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the known materials in the silver halide photographic art for reasonable expectation of obtaining the benefits as disclosed, taught and/or suggested from the secondary references.

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X. Applicant's arguments filed 22 May 2006 have been fully considered but they are not persuasive.

In view of the amendment and arguments on the record filed on 22 May 2006, the applied reference with respect to Sudo et al (5,424,170) as primary reference is withdrawn. The above rejection is new with the use of a new set of the references.

There is no evidence of an unusual or unexpected result over the above applied set of the references.

XI. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

XII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
31 May 2006

HOA VAN LE
PRIMARY EXAMINER
